

REMARKS

Claims 1-11, 14-33 and 47-48 are pending in this Application. By this Amendment, claims 1, 21, 22 and 33 have been amended. No new matter is added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

35 U.S.C. § 101 Rejection

The Office Action rejects claims 1-11, 14-20, 21, 33 and 47 under 35 U.S.C. §101 alleging that the claimed invention is directed to non-statutory subject matter. It is noted that claims 1, 21, 22 and 33 have been amended. To the extent the rejection remains applicable to the claims currently pending, the Applicants traverse this rejection, as follows.

Regarding claim 1, the Office Action, on page 3, states the claim does not “require any machine or apparatus to perform the step.” Amended claim 1 recites a computer-implemented method including at least the following combination of features: “selecting, via the processor...assigning, via the processor...prompting, via the user interface...varying, via the processor...performing, via the processor...iteratively, via the processor...and prompting, via the user interface.” Accordingly, the Applicants respectfully submit claim 1 is tied to a machine and therefore, recites statutory subject matter.

For similar reasons, the Applicants submit the claim 21 recites statutory subject matter under 35 U.S.C. § 101. Accordingly, the Applicants respectfully request withdrawal of the rejection to claims 1-11, 14-20, 21 and 47.

Regarding claim 33, the Office Action states that “the claim is directed to a signal directly or indirectly by claiming *a computer usable medium* and the Specification . . . recites evidence where the medium is defined as a ‘signals’ . . . In that event, the claim is directed to a form of energy which at present the office feels does not fall within at least one of the four enumerated categories of patentable subject matter recited in section 101” (see Office Action, pages 2-3).

It is respectfully submitted that claim 33 does not recite or mention a “signal.” Claim 33 is directed to a “computer program product comprising a computer usable medium having control logic stored therein for causing a computer to provide interactive assistance with populating an automated document.” It is improper to import claim limitations from the specification. See M.P.E.P. section 2111.01. “Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into the claim when the claim language is broader than the embodiment.” See *Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870 (Fed. Cir. 2004). (Emphasis added)

Furthermore, although the Court of Appeals for the Federal Circuit has held that a “signal, standing alone” is not patentable subject matter, the court was careful to distinguish claims directed to “a storage medium holding the resulting signals,” which were allowed by the PTO. See *In re Petrus A.C.M. Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007).

Moreover, the Board of Patent Appeals and Interferences has held that a Beauregard Claim does contain statutory subject matter under 35 U.S.C. § 101. *See Ex Parte Bo Li*, Appeals 2008-1213 (BPAI 2008).

Thus, it is respectfully submitted that claim 33, directed to a “computer program product comprising a computer usable medium having control logic stored therein for causing a computer to provide interactive assistance with populating an automated document,” contains patentable subject matter under 35 U.S.C. §101. Accordingly, the Applicants respectfully request that the Examiner withdraw the rejection.

35 U.S.C. § 103(a) Rejection

The Office Action rejects claims 1-11, 14-33 and 47-48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,270,351 to Roper in view of U.S. Patent Application Publication No. 2004/0148192 to Morley et al. (hereinafter “Morley”) and further in view of U.S. Patent No. 7,398,467 to Bates et al. (hereinafter “Bates”). To the extent that these rejections remain applicable to the claims, as amended, the Applicant respectfully traverses these rejections, as follows.

The Applicants respectfully submit that Roper, Morley and Bates, alone or in combination, do not teach or suggest, a computer-implemented method for providing interactive assistance with populating an automated document that includes at least one field, the computer comprising a processor, a data repository, and a user interface, the method including at least the following combination of features: “selecting, via the processor, an entity to which the document applies; assigning, via the processor, a prioritization to each of the at least one field, the prioritization stored in the data

repository; prompting, via the user interface, for a response for each of the at least one field, the prompting varying based on the prioritization of each of the at least one field; varying, via the processor, a color of each of the at least one field based on the prioritization; performing, via the processor, a compliance check of each response for the at least one field to determine if the response complies with predetermined legal requirements; iteratively revising, via the processor, the prioritization of all of the at least one field upon receiving the response to each of the at least one field; prompting, via the user interface, for a response for at least one field, the prompting varying based on the iteratively revised prioritization of all of the at least one field; and displaying, via the user interface, the populated automated document,” as recited in amended claim 1.

Combining Roper with Morley and Bates would teach away from the principle of operation of Roper and therefore, the combination of these references is improper. Roper, in the abstract, discloses “creat[ing] an individual education plan for the student based on the student’s profile.” The cited portion of Morley discloses “a method for determining employer compliance in determining employment eligibility requirements in accordance with federal immigration regulations.” See the Abstract of Morley. Bates discloses “identifying user-specific proclivities for confusing particular words which, which grammatically correct, are not used as intended by the user.” See the Abstract of Bates. Further, the cited portions of Bates, in col. 3, lines 18-43, discloses “an illustrative problem word table...[where] the priority field 320 indicates a priority level for problem words...[and] the color field 330 indicates a color for a problem word based on the problem words respective priority level.”

Roper is directed to administering an individual education plan, but when combined with Morley's employment eligibility requirements in accordance with federal immigration regulations and Bates' illustrative problem word table identifying user-specific proclivities for confusing particular words, it results in determining whether the school district complied with federal immigration regulations when employing the student and whether the user of the system improperly used words when inputting information regarding the student, which is completely different from the stated purpose of Roper. Thus, the combination of the Roper with Morley and Bates would teach away from Roper's administering an individual education plan.

Further, the Applicants respectfully submit that the Office Action has failed to provide a reason to combine the cited references. The mere fact that the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless there is a rational reason for the modification. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). The Applicants submit that combining the references is improper, and that, even if combined, the references do not disclose the invention as claimed.

The Office Action admits, on page 8, that Roper does not teach "performing a compliance check for each response for the at least one field to determine if the response complies with predetermined legal requirements" and relies on Morley to cure this deficiency. The Office Action, on page 8, asserts "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Roper with Morley because it would have managed all of the employment eligibility forms

associated with particular employers, to assure continued compliance with federal regulations.”

The Office Action’s rejection is based upon impermissible hindsight. The Office Action has failed to provide any reason why one of ordinary skill in the art would combine Roper disclosing “creat[ing] an individual education plan for the student based on the student’s profile,” with Morley, disclosing “compliance in determining employment eligibility requirements in accordance with federal immigration regulations.”

Further, the Office Action admits, on page 9, that “the combination of Roper and Morley does not specifically teach “varying a color of each of the least one field based on the prioritization,” and relies on Bates to cure this deficiency. The Office Action, on pages 9-10, asserts “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bates with Roper as modified by Morley because it would have indicated a priority level for each field in the form and facilitated correction of the fields.”

However, the Office Action has failed to provide any reason why one of skill in the art would combine Roper disclosing “creat[ing] an individual education plan for the student based on the student’s profile,” with Bates, disclosing “identifying user-specific proclivities for confusing particular words which, which grammatically correct, are not used as intended by the user.”

Therefore, the Applicants submit the Office Action has failed to provide a *prima facie* case of obviousness for the features recited in claim 1.

For at least the above reasons, the Applicants submit that claim 1 is allowable over the cited references. For similar reasons, the Applicants submit that claims 21, 22 and 33 are also allowable.

As claims 1, 21, 22 and 33 are allowable, the Applicants submit that claims 2-11, 14-20, 23-32, 47 and 48, which depend from claims 1, 21 and 22, respectively, are likewise allowable over the cited references, as well as for the additional features recited therein.

Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-11, 14-33 and 47-48 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number set forth below.

In the event this paper is not considered to be timely filed, the Applicant hereby petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing Attorney Dkt. No. 026063-00014.

Respectfully submitted,



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